

Practitioner's Docket No. DE9-2000-0072-US1**PATENT**

Assistant Commissioner for Patents
 Washington, D.C. 20231
 ATTENTION: Licensing and Review

PETITION FOR RETROACTIVE LICENSE (37 CFR 5.25)

NOTE: See M.P.E.P. § 140, 6th ed., rev. 3.

1. Petition

It is respectfully requested that this petition for license for foreign filing attached hereto be granted retroactively under the provisions of 37 CFR 5.25.

2. Previous Licenses (☐ applicable ☒ not applicable)

Attached are copies of

- ☐ previous licenses
☐ the filing receipt license

issued on this invention before the export.

3. Material filed abroad without a license

Attached is a copy of the material that was filed abroad without a license for foreign filing.

4. Identification of inventor(s), title of invention and, if applicable, details of corresponding U.S. application

Inventor(s) name(s): Ulrich Baur, Otto Andreas Torreiter, Joseph Eckelman
 David TinSun Hui

Title of Invention: Self-test for Leakage Current or Driver/Receiver Sta

(complete the following, if applicable)

In re application of:

Group No.:

12/11/2001 DBATES 00000010 090456

Application No.: 0 /

Examiner's Name:

01 FC:122

130.00 CH

Filing Date:

5. Foreign Countries and dates of filing of material for which retroactive license requested (37 CFR 5.25(a)(1))

With respect to the material for which a retroactive license is requested, each foreign countries in which the patent application material was filed and the date it was filed is as follows:

Foreign CountryDate

European (Germany)

November 1, 2000

P-103170

RECEIVED
 NOV 11 2001
 DEPT. OF COMMERCE
 PATENT & TRADEMARK OFFICE

6. Verified Statement()

Also attached hereto are the verified statement(s) of:

- 1) Jan Gigerich
- 2) Thomas Reinhardt
- 3) Dr. Wolfgang Kauffmann
- 4) Robert A. Walsh

which confirm(s) that, in accordance with 37 CFR 5.25(a)(3)(i)-(iii),

- (a) the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order;
- (b) the license is being diligently sought after discovery of the proscribed foreign filing; and
- (c) an explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained.

NOTE: See 37 CFR 5.25(a)(4).

7. Fee (37 CFR 1.17(h)—\$130.00)

The fee for this petition for retroactive license is paid by

- ☐ Attached is a ☐ check ☐ money order in the amount of \$ _____
- ☒ Authorization is hereby made to charge the amount of \$ 130.00
- ☒ to Deposit Account No. 09-0456
- ☐ to Credit card as shown on the attached credit card information authorization form PTO-2038.

WARNING: Credit card information should **not** be included on this form as it may become public.

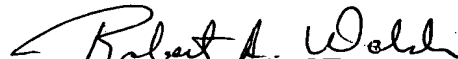
- ☒ Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

Reg. No.: 26,516

Tel. No.: (802) 769-9521

Customer No.: 024241



SIGNATURE OF PRACTITIONER

Robert A. Walsh

(type or print name of practitioner)

IP Law Dept., 972E, IBM CORPORATION
P.O. Address

1000 River St., Essex Jct, VT 05452

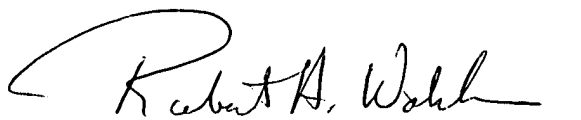
Verified Statement
Petition for Retroactive License

Attorney Docket: DE9-2000-0072-US1

This European case was filed first as European Patent Application, Number 00123770.0, through error and without deceptive intent without the required License under 37 CFR 5.11 first having been obtained.

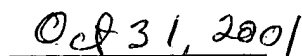
This oversight was first noted by me, Robert A. Walsh, on October 3, 2001 during preparation of the case for filing with the United States PTO. After reviewing the paperwork for the "Declaration and Power of Attorney for Patent Application", I became aware that two of the four inventors (Joseph Eckelman and David TinSun Hui) are citizens of the United States of America. I immediately began to investigate as to whether a License under 37 CFR 5.11 was first obtained prior to filing this case in the European Patent Office. On the same day, October 3, 2001, I was able to determine that a License under 37 CFR 5.11 was not obtained, and I began to have the appropriate forms and statements prepared for a Retroactive License under 37 CFR 5.25. The appropriate forms and statements for a Retroactive License under 37 CFR 5.25 and are being submitted herewith.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Robert A. Walsh

Reg. # 26,516



Date

Verified Statement

Attorney Docket: DE9-2000-0072-US1

This European case was filed first as European Patent Application, Number 00123770.0, through error and without deceptive intent without the required License under 37 CFR 5.11 first having been obtained.

The reason for such filing was due to the following facts:

The invention was originally disclosed to the Intellectual Property Department in Germany by Otto Torreiter. The inventors Otto Torreiter and Ulrich Baur are German citizens. The US inventor Joseph Eckelman stated that the invention was developed predominantly in Germany and the US inventor David Hui stated that the invention was done with conference calls between US and Germany. Therefore it was my belief that the invention was not made in the US.

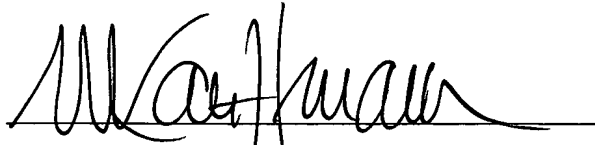
Further, the information exchanged which is contained in this European Patent Application is subject matter which is normally exchanged between the parties named as inventors, who are employees of International Business Machines Corporation in Europe and the United States, on a regular basis. Such exchanges are not subject to any export license. Therefore, the application is not subject matter under any export prohibition or secrecy order.

This oversight was recently noted and a petition for a retroactive license is being sought.

The undersigned had personal knowledge of the foregoing associated in the filing of this application in the European Patent Office.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are

punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Signature

DR. WOLFGANG KAUFFMANN

Name (Printed)

23. Oct. 2001

Date

Verified Statement

Attorney Docket: DE9-2000-0072-US1

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Signature

JAN GIGERICH

Name (Printed)

23. Oct. 2001

Date